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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/560,266	05/11/2006	Michael Mittelstein	NEOME-019A1US	3475
7590 07/29/2009				
Robert D Buyan Stout, Uxa, Buyan & Mullins 4 Venture Suite 300 Irvine, CA 92618			EXAMINER SHAY, DAVID M	
			ART UNIT	PAPER NUMBER
			3769	
			MAIL DATE	DELIVERY MODE
			07/20/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/560,266

**Applicant(s)**

MITTELSTEIN ET AL.

**Examiner**

david shay

**Art Unit**

3769

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on March 30, 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 4-17, 25-29 and 32-53 is/are pending in the application.
- 4a) Of the above claim(s) 35-51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4-17, 25-29, 32-34, 52 and 53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Applicant argues that the device as now claimed reads over the references of record. The examiner cannot agree. The device of Baerveldt et al contains many of the claimed elements, with the exception of the location of the infusion port. However, such location of a fluid flow port – in the side of the outer tube – is a well known location for fluid flow ports in the art, as shown by Eichenbaum. Thus this argument is not convincing.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 25-29, 33, 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 24-29 are indefinite because they depend from a canceled claim. For the purposes of examination, these claims will be treated as depending from claim 1, as this is the claim that the limitations of claim 24 have been incorporated into.

Claims 1, 4-17, 25-29, 32-34, 52, and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baerveldt et al in combination with Eichenbaum. Baerveldt et al teach a device which has either an optical fiber, a bipolar or monopolar electrode, a mechanical cutter, or an ultrasound device within a tissue protecting sheath which is an insulator and transmits energy to cut ocular tissue, a shield is provided (e.g. footplate, 721), which protects tissue (see paragraph [0094]) and which can be made of or coated with an insulating material (see paragraphs [0095] and [0098]), and teaches the equivalence of one-contained-within-the-other and side-by-side arrangement of irrigation and aspiration tubes (see e.g. Figures 22 and 23). Eichenbaum teaches a device such as claimed including tubes with one-contained-within-the-other for irrigation and

aspiration; an opening in the side of the outer tube to allow for fluid flow; and the inner tube extending out beyond the distal end of the outer tube, the outer tube being sealed against the outer surface of the inner tube (see e.g. Figure 3, element 73 and column 5, lines 36-39). It would have been obvious to the artisan or ordinary skill to employ the irrigation and aspiration tubes which are one-contained-within-the-other throughout their entire length; various excision modalities; and the insulative coating of Beaveldt et al in the device of Eichenbaum, since these are recognized equivalents in the art, as taught by Baerveldt et al, and since the insulation would be required to prevent thermal damage to adjacent tissues, as taught by Baerveldt et al, or alternatively, to provide the hole in the side of the outer tube to provide fluid flow, as taught by Eichenbaum in the device of Baerveldt et al, since this is not critical; is well within the skill of one having ordinary skill in the art; provides no unexpected result; and is widely recognized location for an irrigation or aspiration opening in the art, and in either case, skill to use polyimide for the insulator, since this is not critical; is well within the skill of one having ordinary skill in the art; provides no unexpected result; and is a known insulator in the art, with regard to claims 33 and 34, these are product by process claims and, absent a showing from applicant are not structurally different from the combined device of and Eichenbaum thus producing a device such as claimed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to david shay whose telephone number is (571) 272-4773. The examiner can normally be reached on Tuesday through Friday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, II, can be reached on Monday, Tuesday, Wednesday, Thursday, and

Friday. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/david shay/

Primary Examiner, Art Unit 3769